

REMARKS:

Status of claims and amendments

Claims 1-8 are pending in the application. In the Office Action dated April 11, 2006, the Examiner

1. rejected claims 6-8 under 35 U.S.C. 112, second paragraph, as being indefinite;
2. rejected claims 1-3 and 6-7 under 35 U.S.C. 102(a) as being anticipated by JP2002-186807 (“ ‘807”);
3. rejected claim 4 under 35 U.S.C. 103(a) as being unpatentable over ‘807 in view of JP2001-269514 (“ ‘514”);
4. rejected claims 5 and 8 under 35 U.S.C. 103(a) as being unpatentable over ‘807 in view of ‘514 (claim 5) or in view of ‘807 (claim 8) and further in view of Dewey.

In this amendment, claim 6 has been amended to overcome the 112 rejection. New claim 9 has been added to further distinguish the present invention over the prior art. No new matter was added.

The 112 rejection

Claim 6 has been amended to correct the antecedent basis of “the hollow portion.”

‘807: the 102 and 103(a) rejections of all pending claims

‘807 discloses a filtration element 23 having a screen 24 and a relief valve 30 which opens/closes a by-pass route 34 (abstract and FIGs.). Oil which passes through the by-pass route defined by valve 30 does not, by definition, pass through screen 24; see especially FIGs. 2 and 4. ‘807 therefore does not disclose or suggest “a nonwoven fabric oil filter...for filtering oil flowing from the valve body into the hollow portion,” (inventive claims 1 and 6). All other pending claims depend directly or indirectly from claim 1 or claim 6. All pending claims are thus patentable over ‘807 in view of various combinations of ‘514, ‘807, and Dewey.

New claim 9

In addition to the reasons pointed out above, new claim 9 is further patentable over '807, '514, and Dewey since it contains the limitation of "a first cover member configured and dimensioned for *a substantial portion thereof* to be mounted to an open side of a valve body" (emphasis added). See the FIGs. for support for this limitation. The casing 27 of '807 is much larger than valve 30. The combination of the valve body and the filter, therefore, is smaller in the present invention than in the prior art. This limitation is neither disclosed nor suggested by '807. Claim 9 is thus patentable over '807, '514, and Dewey.

Conclusions

In view of the foregoing, Applicant believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance is respectfully requested.

Authorization is granted to charge any outstanding fees due at this time for the continued prosecution of this matter to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (matter no. 060944-0175).

Respectfully submitted,



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